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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,776	10/23/2000	Joseph Sforzo		8512

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,776

Applicant(s)

SFORZO, JOSEPH

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17,20-35 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17,20-35 and 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment filed 10/23/2004.

Response to Amendment

2. The examiner regrets delay in receiving the prior office action which occurred as a result of the office action mailed to wrong address.
3. In response to the arguments presented in the response, the examiner has withdrawn the restriction requirements stated in the previous office action.
4. Claims 2-17, 20-35 and 38-47 remain pending and have been examined.
5. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment.

Claim Objections

6. Claims 38-47 are objected to because of the following informalities: certain limitations are separated by a semicolon (;) or period (.) as applicable. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

In claim 40 the step "providing a computer network with the identity of an applicant.." limitation "said surety" lacks proper antecedent basis. It is assumed that the "selecting surety" step is performed prior to the providing step.

Claim Rejections - 35 USC § 103

8. Claims 2-17, 20-35 and 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wulff (Building credibility with contactors and sureties), American Agent and Broker v68n7 PP: 24-27 July 1996, (Wulff) and further in view of US Pat. 6,347,302 (Joao) and further in view of Official Notice.

Regarding claims 38 Wulff teaches the steps (a) - (c) as follows:

an agent selecting a surety from one or more sureties (see pg. 1 "we provide ..varieties of bonds);

providing said surety with the identity of an applicant .. and such other information (see pp. 2 and 3 "a list of the information we need to thoroughly underwrite the account.. This helps us ..putting together the submission for the surety)";

receiving from said surety a decision on whether the bond is approved (see p. 3 para "Surety ..can usually have a response to a goods submission..");

Joao, in the same field of endeavor teaches a method of obtaining sureties (insurance policies) over a communication network comprising:

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(e) permitting a third party (business entity) requiring said sureties (insurance policies, products, services and coverages etc.) to access said sureties (see col. 17 L 25-33 On-line dissemination);

(f) issuing said surety bond through said communication network to said third party (see discussion of step (e)).

While Wulff and Joao fail to explicitly teach step (d) providing an authorization code for an approved bond to the applicant, Official notice is taken it is old and well known to associate an authorization code with a surety bond, insurance policies etc, and to provide it to the applicant when such documents are approved or delivered to the applicant (such a reference or document identifier, for instance, a policy number can serve as an access code) serves a convenient way to satisfy legal requirements by presenting the access code in cases where businesses or government authorities require insurance policy or surety bond.

It is also asserted that Joao, inherently, teaches such an access code because a third party such as a an individual or business entity cannot access insurance information without having a access/reference code.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Wulff, Joao and the officially noted facts to obtain to:

(a) carry out the method steps of providing the identity of the applicant and other information, and (f) issuing the surety bond through the communication network per disclosure of Wulff over a communication network as per Joao because it would improve convenience, availability of the process of obtaining the surety, it would also reduce cost by eliminating manual labor.

(b) providing an access code to the applicant would eliminate need for physical delivery of the surety bond which would improve convenience of record keeping because it would eliminate of maintaining and carrying paper documents associated with the surety bond (refer to Joao which realized this benefit see col 14).

Claim 2: refer step d) discussed in claim 38 analysis.

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Claims 3-16: Wulff teaches that the bonds can be of any type including those recited in the subject claims. (see p.1) It is also asserted that the method of obtaining a surety bond per claim 38 is not patentably distinguished for *which* type of surety bond is issued. In this regard Wulff in combination with Joao and the official notice are applicable regardless of the type of the surety bond.

Claim 17: network is accessed by a password and the bond is accessed by the authorization code.

(refer to claim 38 for discussion of authorization code. Accessing the network by a password is well known step inherently shown in the Joao reference)

Claim 39: all limitation are analyzed as per claim 38 analysis in light of the combination of Wulff, Joao, and the official notice.

Claim 40: all limitation are analyzed as per claim 38 analysis in light of the combination of Wulff, Joao, and the official notice.

Claim 41: recites a system that corresponds to method claim 38. Accordingly limitations (a)-(f) are addressed in respective method steps (a)-(f).

Claim 42: recites a system that corresponds to method claim 39. Accordingly limitations (a)-(g) are addressed in respective method steps (a)-(g).

Regarding claim 43, Wulff and Joao in combination while teaches the process of selecting a surety, providing the selected surety with identity of an applicant, receiving a decision from said surety, accessing an authorization code for an approved bond, permitting a third party to access said bond through the access code and issuing the bond as per claim 38 analysis. Joao teaches work station capable of performing the process of the client work station (see Fig. 5 and col. 15 L 67-12 and col. 16 L 56-65), Joao further teaches a second work station permitting a third party receiving the authorization code and issuing a bond to the third party (see Fig. 5 remote

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user device). (please refer to detailed analysis of claim 38 for relevant discussion and motivation.).

Claim 44 and 45: said agent provides said surety with a name of a contractor, contractor's address, the identity of an owner/obligee for whom the bond is required, an identification of the bond form required, an estimated contract price, an amount of the bid security, a contract number or IFB number and a description of the job.

(refer to information we need to thoroughly underwrite the account on p. 2 of Wulff).

Regarding claims 46-48: Per analysis of claim 38, Wulff and Joao in combination teaches the process of creating a bond request, selecting a surety, selecting a surety, selecting a bond from the group and transmitting the information electronically to the surety company. The cited references further teaches authorization code which is to be presented at a bid letting.

As per claim Wulff in combination with Joao teaches that the method which comprises the recited process steps is implemented on a world wide web (see col. 16 L 56-65).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Wulff, Joao and the officially noted facts to perform the method over a World Wide Web having a website of the bonding agency (providing a financial instrument analogous to insurance policy provided over the world wide web via a web page as disclosed in Joao) because numerous benefits of obtaining a surety bond over from a website of the bonding agency such as disclosed in Wulff are well established and well known a person of ordinary skill in the art such benefits as wide spread distribution of services, convenience of receiving financial service at any desired location (home or office).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

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ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

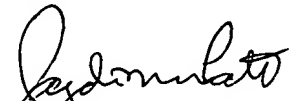
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

1/10/05